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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: : Supre, Inc.
Mark: : HEMPZ
Serial No. : 78/016,669
Filed : July 13, 2000
Class : 3
Examining Attorney : Irene Williams
Law Office : 112

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APPLICANT'S APPEAL BRIEF

I. Introduction

Applicant appeals the final decision of the United States Patent and Trademark Office Examining Attorney refusing registration of the above-referenced mark. The Applicant filed its application to register the mark HEMPZ on July 13, 2000. The Examining Attorney mailed her Final Refusal on April 24, 2001. The Applicant noticed its appeal from that final rejection on October 24, 2001.

The Examining Attorney has refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052 (e)(1) on the basis that Applicant's mark merely describes the goods. As set

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forth in the following sections of this appeal brief, Applicant believes the Examining Attorney's contentions to be in error and asks that the Board reverse her refusal and pass this mark to publication.

II. Relevant Facts

Applicant filed its application for registration of the mark HEMPZ on July 13, 2000, for use in connection with skin care preparations, namely, non-medicated indoor and outdoor tanning preparations and moisturizers, in International Class 3. The application was assigned Serial No. 78/016,669.

On December 12, 2000, the Examining Attorney mailed an Office action refusing registration on the basis that, among other things, the Applicant's mark is merely descriptive because "the term HEMPZ merely describes a skin care system which uses hemp or hems." The Examining Attorney noted that "'hems' is merely the phonetic equivalent of 'hems'," and that this is a common ingredient in skin care preparations. (It is assumed that the Examining Attorney intended to state that "'hempz' is merely the phonetic equivalent of 'hems'.")

On February 20, 2001, Applicant timely filed its response to the Office Action addressing the Section 2(e)(1) refusal. On April 24, 2001, the Examining Attorney mailed her Final Action refusing registration of Applicant's mark. On July 3, 2001, Applicant filed its Request for Reconsideration, and on August 30, 2001, the Examining Attorney mailed her action denying the request and adhering to the Final Action. Applicant filed its Notice of Appeal on October 24, 2001.

III. Argument

To be refused registration on the Principal Register under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively

misdescriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The determination of whether or not a mark is merely descriptive must be made not in the abstract but, rather, in relation to the goods or services for which registration is sought; the context in which the mark is used, or intended to be used, in connection with those goods or services; and possible significance which the mark would have, because of that context, to the average purchaser of the goods or services in the market place. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Applicant respectfully asserts that its mark is not merely descriptive. The mark consists of a coined term invented and selected for the sole purpose of functioning as a trademark and, as such, is fanciful. See *Tisch Hotels, Inc. v. Americana Inn, Inc.*, 350 F.2d 609, 146 USPQ 566 (7th Cir. 1965). Applicant's mark is comprised of a word that is neither used nor known in the English language. Neither the word "hempz," nor its phonetic equivalent "hemps," exist in the English language. The English word "hemp" is used to connote both singular and plural forms, never necessitating use of the letter "s" to denote a plural form. The Examiner states that the mark is merely descriptive, but the concept of mere descriptiveness must relate to general and readily cognizable word formulations and meanings, either in popular or technical usage context. *In re Shutts*, 217 USPQ 363 (TTAB 1983). The term "hempz" is not a readily cognizable word formulation in any context.

Applicant asserts that fanciful marks are the strongest of all marks in that their novelty creates a substantial impact on the buyer's mind. *Aveda Corp. v. Evita Marketing, Inc.*, 706 F.Supp 1419, 12 USPQ2d 1091 (D. Minn. 1989); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11:6 (1992). The mere fact that Applicant's goods contain a form of hemp does not rule out a finding that the mark is fanciful, or necessitate a finding of descriptiveness. Examples of some marks declared fanciful, but which, like Applicant's mark, contain some vague reference to an ingredient found in the product or a use made of the product are:

- (1) CLOROX (for bleach) - containing calcium hydroxide, calcium **chloride** and calcium hypochlorite. *Clorox Chemical Co. v. Chlorit Mfg. Corp.*, 25 F. Supp. 702 (D.N.Y. 1938);
- (2) CUTEX (cuticle-removing liquid). *Northam Warren Corp. v. Universal Cosmetic Co.*, 18 F.2d 774 (7th Cir. 1927);
- (3) ARGYROL (antiseptic) - containing a silver-protein compound. (**AG** is the chemical element for silver.) *Barnes v. Pierce*, 164 F. 213 (C.C.D.N.Y. 1908).

Applicant's mark is no less fanciful than these marks. Applicant has simply developed a new trade symbol for its product.

Applicant also asserts that its mark is not merely descriptive as it does not describe a significant ingredient or property of Applicant's product. The first eleven ingredients found in Applicant's product are listed below in order of the percentage of each ingredient used to make up the total product, beginning with the ingredient which is most significant to the overall formula:

1. Purified Water
2. Isopropyl Palmitate
3. Propylene Glycol
4. Stearic Acid
5. Glyceryl Stearate
6. PEG 100 Stearate
7. Polysorbate 40
8. Triethanolamine
9. Sorbitan Palmitate
10. Aloe Vera Gel
11. Cannabis Sativa

As the list indicates, the main ingredient in the product is Purified Water. Cannabis Sativa is eleventh on the list, indicating that Applicant's product contains no more than 1% Cannabis Sativa, a form of hemp. Thus, hemp is not a significant attribute or property of Applicant's goods.

Should the Board disagree with Applicant's assertion that its mark is fanciful, Applicant states that, at the very least, its mark is suggestive. A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976). If the mark stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive. *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 188 USPQ 623 (7th Cir. 1976), *cert. denied*, 429 U.S. 830 (1976). The immediate idea must be conveyed

with a degree of particularity. *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978).

As the borderline between descriptive and suggestive marks is hardly a clear one, courts have used various tests for determining the difference. These tests include: 1) the dictionary definition; 2) the imagination test; and 3) the competitors' need test. See *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 217 USPQ 988 (5th Cir. 1983).

A. Dictionary Definition

There is no dictionary definition of the word "hempz" or "hemp." Though the fact that a term is not found in the dictionary is not controlling on the question of registrability, in such instances the Examining Attorney must show that a term has a well understood and recognized meaning. See *In re Gould Paper Corp.*, 834 F. 2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic for premoistened antistatic cloths for cleaning computer and television screens); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPREAD held merely descriptive of jellies and jams). In the instant case, the mark HEMPZ has no well understood or recognized meaning, and the Examining Attorney has failed to demonstrate that such a meaning exists.

The dictionary definition of the word "hemp," as provided by the Examiner, is: (1) Cannabis, (2) The tough, coarse fiber of the cannabis plant, used to make cordage; (3a) Any of various plants similar to cannabis, especially one yielding a similar fiber; and (3b) The fiber of such a plant. The Examiner's statement on page 1 of the Office Action mailed April 24, 2001, (attached as Exhibit A) indicates that the "dictionary citations of the previous and present action show that hemp is a specific ingredient used in skin care preparations." However, nowhere does this definition of hemp make reference to skin care preparations. Applicant maintains that the

Examiner has relied upon a dictionary definition which would escape the knowledge and impressions of the average purchaser about "hemp" and thus exaggerates the mark's descriptive significance. *See In re Shutts*, at 364. The incongruity of applying the mark HEMPZ to a tanning lotion invests it with a suggestive rather than a descriptive character. *Id.* The term "hempz," as applied to Applicant's tanning lotion, does not readily and immediately evoke an impression and understanding of Applicant's product as a tanning lotion.

Webster's Ninth New Collegiate Dictionary defines hemp as: (1a) tall widely cultivated Asian herb (*Cannabis sativa*) of the mulberry family with tough bast fiber used esp. for cordage; (1b) the fiber of hemp; (1c) a psychoactive drug (as marijuana or hashish) from hemp; (2) a fiber (as jute) from a plant other than the true hemp; *also*: a plant yielding such fiber. Based upon the complete definition of "hemp," consumers will not immediately associate either the term "hempz" or the term "hemp" with tanning products. They are more likely to associate these terms with the drug marijuana or with rope products.

B. Imagination Test

The more imagination that is required on the consumer's part to get some direct description of the product from the terms, the more likely that the term is suggestive. Under the imagination test, one must ask how quickly and directly the thought process from the mark to the particular characteristic of the product is completed. If one must exercise "mature thought or follow a multi-stage reasoning process" to determine attributes of the product or service, the term is suggestive, not descriptive. *In re Tennis in the Round, Inc.*, 199 US PQ 496 (TTAB 1978); *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 2 USPQ2d 1204 (9th Cir. 1987) ("If a consumer must use more than a small amount of imagination to make the association [of product

attribute], the mark is suggestive and not descriptive.”) If the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness. *Investacorp, Inc. v. Arabian Investment Banking Corp.*, 931 F.2d 1519, 19 USPQ2d 1056 (11th Cir.1991).

In the instant case, neither the term “hempz” nor the term “hemp” directly or clearly conveys information about the goods in question. Multi-stage reasoning is required for consumers to make the connection between the terms “hempz” or “hemp” and tanning lotion. There is no instantaneous mental leap from one to the other. Applicant argues that consumers are more likely to associate the terms “hempz” or “hemp” with the cannabis plant and the drug marijuana, as is illustrated by a mere sampling of the large number of articles linking the two which the Applicant has attached (Exhibit B) .

C. Competitors’ Need Test

The more imagination that is required to associate a mark with the product, the less likely the words used will be needed by competitors to describe their products. *Educational Dev. Corp.*, 562 F.2d 26, 195 USPQ 482 (10th Cir. 1977). If the suggestion made by the mark is so remote and subtle that the mark is really not likely to be needed by competitive sellers to describe their goods, this indicates that the mark is merely suggestive, not descriptive.

In the instant case, it is difficult to perceive any competitive need to use “hempz” or “hemp” in describing tanning products. Applicant’s competitors have a host of other terms available to describe such products. Applicant’s search of trademark databases uncovered only four marks for use in connection with tanning products which contain the word “hemp.” Even those who used the word exhibit an unlimited array of choices of other terms with which to

combine "hemp." These competitors used HEMP PLUS (Reg. No. 2,173,938), ROYAL JAMAICAN HEMP (Ser. No. 75/690,625), WILD HAWAIIAN HEMP (Ser. No. 75/689,523) and HEMP IT'S MAGIC & SPIRIT (Reg. No. 2,277,021) (see attached Exhibits C, D, E, and F).

Applicant's mark had no existence as a word before Applicant devised it. It neither looks like nor sounds like any word which one of Applicant's competitors might want to use in merchandizing. *See Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903, 94 USPQ 363 (3rd Cir. 1952). Thus, the only restrictive effect which could be anticipated from Applicant's exclusive use of this coined word as a trademark would be to prevent subsequent applicants from using other words of similar sound or appearance in confusing ways.

For the reasons discussed in connection with this three-part test, Applicant's mark is suggestive rather than descriptive, and is entitled to registration. *See Philip Morris*, 207 USPQ 451 (holding that SOFT SMOKE is suggestive rather than descriptive for smoking tobacco since, although the mark suggests some characteristic of Applicant's smoking tobacco, the suggestion may not be clear or immediately perceptible or even the same for each user); *In re De-Raef Corp.*, 120 USPQ 318 (TTAB 1959) (reversing an examiner's refusal to register CULTURED for pancake mix even though the term may suggest to some purchasers that cultured milk is used as an ingredient of the product); *See Application of Colonial Stores Incorporated*, 55 CCPA 1049, 394 F.2d 549 (1968) (reversing the decision of the TTAB and holding that SUGAR & SPICE, when used in connection with bakery goods, does not merely denote ingredients of the goods).

While a descriptive term immediately tells something about particular goods or services, it has been held that a mark does not have to be devoid of all meaning in relation to the goods and services to be registrable. *See In re Shutts*, at 364 (the TTAB recognized that the mark SNO-RAKE was used in connection with a snow removal tool, but still found the mark suggestive);

TMEP§1209.01(a). In the instant case, the mark HEMPZ certainly contains a form of the term "hemp," and the product certainly contains a hemp seed extract, but the mark is still suggestive of Applicant's goods. The mark does not convey a readily understood meaning to the average purchaser of such goods. *See In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

It has been widely held that the distinction between marks which are merely descriptive and marks which are suggestive is so nebulous that more often than not, determinations are made on a subjective basis with any doubt being resolved in favor of the applicant. The TTAB and the courts have followed this holding based upon the reasoning that harm will be avoided because any person who believes that he would be damaged by a registration would still have the opportunity to oppose the registration of the mark upon its publication. *In re Atavio, Inc.*, 25 USPQ 2d 1361 (TTAB 1992); *In re Aid Laboratories, Incorporated*, 221 USPQ 1215 (TTAB 1983); *In re Shop-Vac Corporation*, 219 USPQ 470 (TTAB 1983); *In re Shutts*, at 365; *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972). The TTAB has the burden of proof on this issue. *In re Merrill Lynch Pierce, Fenner & Smith, Inc.*, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Applicant requests that any doubt as to the descriptive or suggestive nature of the mark be resolved in its favor.

Additionally, Applicant respectfully asserts that its mark is no more descriptive, or less suggestive, than the aforementioned HEMP PLUS, ROYAL JAMAICAN HEMP, WILD HAWAIIAN HEMP and HEMP IT'S MAGIC & SPIRIT marks, and that its mark is equally entitled to proceed to registration.

IV. Conclusion

To summarize, the factors favoring Applicant are the fanciful, or at least suggestive, nature of the mark. For all the foregoing reasons, Applicant submits that the Examining

Attorney's refusal should be reversed and the application to register this mark should be passed to publication.

Respectfully submitted,

**WORSHAM FORSYTHE
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Dated: December 21, 2001

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